Remarks

Applicant's undersigned representative thanks the Examiner for the courtesy of a telephone interview to discuss the rejections set forth in the Office Action. The present amendments and remarks are provided in accordance with the discussions conducted during the telephone interview.

Claims 1-32 are currently pending in the subject application. Based on at least the following remarks, reconsideration and allowance are respectfully requested for claims pending in the present application:

Claim Rejections under 35 U.S.C. § 112

Claims 1-32 stand rejected as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as his invention. In view of the following remarks, applicant submits that the limitations in question are sufficiently definite and have adequate support in the specification as submitted.

For purposes of various arguments presented herein, applicant invites attention to MPEP § 2173.02, which reads, in pertinent part that "[d]efiniteness of claim language must be analyzed, not in a vacuum, but in light of: (A) The content of the particular application disclosure[]."

Claims 1 and 32 were rejected due to the "reviewing" step being indefinite. Applicant respectfully directs the Examiner to paragraph 63 of the present application, in which, "[a]s a preparatory step, the user determines in step 95 if this is a preexisting asset matching record... ." As is demonstrated from the foregoing example, a user may review an asset document to determine if there is a corresponding record in a database. It is not necessary that the term "reviewing" be set forth explicitly in the specification. *See Cordis*

Corp. v. Medtronic AVE Inc., 67 USPQ2d 1876 (Fed. Cir. 2003) (the patent specification must describe an invention in sufficient detail that one skilled in the art can clearly conclude that the inventor invented what is claimed; however, the disclosure as originally filed does not have to provide *in haec verba* support, or a verbatim recitation of the claim limitations, for the claimed subject matter at issue).

Claims 1 and 32 were further rejected due to the "receiving" limitation being indefinite. Specifically, the Examiner stated that, "it is unclear if the database is receiving the whole document or data from the document." Applicant points out, for example, that the "user []inputs asset data in step 101 into the record." It is clear that the database is receiving data from the document.

In addition, Applicant notes that the "reviewing" and "receiving" terms, among other claim terms, are included within the "Summary of the Invention" section of the application. (See Specification, paragraphs 9-14).

Claims 1 and 32 were further rejected due to the limitation "standard" being indefinite. Applicant respectfully directs the Examiner's attention to paragraph 58 which discloses "a preprogrammed standard, a banking standard or legal standard... ." By way of example, dependent Claims 7 and 10 illustrate two standards that may be applied to embodiments of the present invention.

Claims 1 was further rejected due to the "said record" limitation in line 9 lacking antecedent basis. Applicant respectfully directs the Examiner's attention to the preamble of Claim 1 which recites "at least one record therein..." ("If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim

preamble is necessary to give life, meaning and vitality to the claim, then the claim preamble should be construed as if in the balance of the claim." *See* MPEP § 2111.02).

Claims 2, 21, and 31 were rejected due to the limitation "providing specific information contained in the asset document to a user." Claims 2, 21, and 31 have been amended to reflect "providing specific information contained in the record to a user". In particular, "asset document" has been replaced with a "record" element.

Claim 2 was rejected due to the limitation "the associated record" in line 4 lacking antecedent basis. Applicant respectfully directs the Examiner's attention to line 3 of Claim 2, which recites, "associating an asset with a record in a database." From the context of Claim 2, therefore, it is clear that the "associated record" limitation is the record whose antecedent basis is established in line 3 of Claim 2.

The Examiner rejected Claim 5 due to the "extracting" limitation being indefinite based upon where the information is being extracted. In particular, the Examiner stated that, "it is unclear if the extraction is performed on the asset document or the associated record which contains the asset document data." This is a distinction without a difference. The record contains information from the asset document. To align Claim 5 with the changes made in Claim 2 above, however, and in the interest of expediting prosecution of the present application, "asset document" has been deleted from line 6 and replaced with a "record" element.

The Examiner rejected Claim 25 based upon the order of retrieving comparison data and generating comparison data. Claim 25 has been amended to reflect that generating comparison data comes before retrieving comparison data. Claim 25 was further rejected by the Examiner due to it being unclear, "if the record consists of documents or data from the

documents." Claim 25 has been amended to add "information from" before "a plurality of the asset documents" in lines 5-6. Finally, Claim 25 was rejected due to insufficient antecedent basis for the limitation "the multiple records" in line 19. Claim 25 has been amended to delete the instance of "the" preceding the "multiple records" element.

The Examiner rejected Claim 30 asserting that the limitation "means for extracting information" is indefinite as to what information is extracted. Claim 30 has been amended to add "aggregated" before "information" in line 19 of Claim 30.

Claim Rejections under 35 U.S.C. §102

Claims 1-2, 4, 6-8, 16, 20-32 stand rejected under this section in view of McDonald et al. (U.S. Pat. Appln. No. 2004/0019558). In the context of the following remarks, applicant notes that, "for anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly." (See MPEP §706.02 - Rejection on Prior Art).

McDonald generally relates to a method and apparatus for collecting information necessary for originating a mortgage loan. McDonald specifically provides, "*a* mortgage loan and financial services data processing system...*to originate a real estate loan or mortgage transaction* for potential homebuyers or homeowners." (See McDonald "Summary of the Invention" – emphasis added). It is clear that McDonald relates to tracking information for a single loan for use in originating the loan. For example, McDonald calls for entry of property information for a single loan including "sales price of *home*" (emphasis added) meaning that a single asset (i.e., a single home) is associated with origination of the loan for the single asset. (See McDonald - box 220 of Fig. 3 of Sheet 7 of 47). Thus, not only

is McDonald focused merely on loan origination, it is also focused only on processing data associated with a single asset for each loan origination.

In contrast to McDonald, various claims of the present application recite, among other elements, a "securitization" limitation that contemplates processing data associated with "multiple assets" or multiple loans. The specification of the present application offers methods and systems that provide, "rigorous collection of loan documentation . . . for securitization." (See paragraph 82). These methods and systems of the present application, "validate information taken from a plurality of asset documents . . . thereby reducing or eliminating costly due diligence prior to securitization." (See Specification, paragraph 83).

It is important to understand the complexity of the task of preparing documentation for a securitization, which is the typical operational environment in which the claimed invention is practiced. The securitization process is described in the "Description of the Invention Background" section of the present application (See, *e.g.*, paragraphs 3, 4 and 6 of the Specification, which have been reproduced here for convenient reference):

> In the course of a securitization, the lender or originator typically transfers the loan into a legal entity known as a Special Purpose Vehicle (SPV) or a trust. The SPV structure provides the investor with protection if the originator becomes bankrupt and makes it easier for the originator to classify the transfer of loans or assets as a sale. The SPV issues securities whose principal and interest are paid by cash flows generated by the loans. The SPV passes the consideration paid by the investors to the originator. The securities issued by the SPV are subject to securities laws and regulatory authorities such as the Securities and Exchange Commission. As such, it is necessary for the lender who originates the loans to abide by laws, regulations and customs regarding full disclosure of information for use by purchasers of the securities.

> At the time of the sale of the assets to the trust or SPV, the lender must make representations and warranties that usually include a statement to the effect that there are no material errors in the data and/or documents provided by the lender to purchasers for the purpose of evaluating assets. If a material error is found in the data, the lender may need to repurchase the loan from the trust. This could potentially cause significant losses to the lender and potentially damage the lender's reputation for reliability in the securities markets. Furthermore, these representations and warranties may cover significant characteristics of the portfolio of loans and exceptions to underwriting policies. The support for making many representation and warranty statements lies originally in the loan documents and is aggregated in data files by the lender and then delivered to investors for use in portfolio analysis. A lender who is unable or unwilling to aggregate the data contained in the documents can cause an investor to perform labor intensive due diligence on every asset in the portfolio. Such investor due diligence requirements may cause the potential investor to discount assets. Other complications can include assets that are unprofitable for the lender to sell or which simply cannot be sold due to unknown risks.
>
> . . . .
>
> In one example, a securitization may contain as many as several hundred loans, each with several hundred documents. A data file is provided to all prospective investors and contains many individual data points that must be tied to a specific document in the loan file. Prospectus material, loan sale agreements, and economic valuation models are based on this data. Because loans are usually made over a long period of time and may come from a number of lenders, a great challenge is presented by collecting, validating, standardizing, and distributing data to meet the standards required by the securities market.

Claim 1 of the present application recites the "securitization" limitation coupled with the "multiple assets" limitation: "wherein said output data includes at least asset data related to *multiple assets associated with a securitization.*" (See Claim 1 - emphasis added). Claim 30 of the present application recites, "a *plurality of commercial mortgage loans* . . ." and "an asset analysis means for determining if the commercial mortgage loan is

prepared for *securitization.*" (See Claim 30 - emphasis added). Also, Claim 31 of the present application recites, "generating common information from a *plurality of the [asset document] records* where the common information is generated *for the purpose of securitizing the asset* into a trust and providing common information to potential investors in the trust." (See Claim 31 - emphasis added). Therefore, for at least the reason of its failure to teach, suggest or disclose the "multiple asset" or "securitization" limitations of the present claims, McDonald does not anticipate the claims of the present application.

In addition, McDonald does not discuss anything akin to a "flow basis" timing of information entry as recited in the claims of the present application. The Examiner relies upon McDonald paragraphs 124, 127, 130, 137 and 138 to support the proposition that McDonald discloses timing of information entry. For example, paragraph 130 of McDonald merely discusses the transfer of information from the originator's software system and that, "the originator will manually input any other required information not already provided by the originator's software system," but timing of data input is not addressed. Applicant respectfully asserts that none of these paragraphs in McDonald recite timing requirements for information entry related to a mortgage or loan involved in a securitization. In contrast to McDonald, Claims 1, 2, 21, 25, and 30-32 of the present application recite, among other elements, a "flow basis" limitation related to the timing of information or data receipt, entry and/or inventorying. Therefore, applicant submits that McDonald does not teach, disclose or suggest the "flow basis" limitation as recited in various claims of the present application.

The specification of the present application provides for collection or validation of information, "as the loan documents become available to those concerned with loan origination, maintenance, and securitization, thereby reducing or eliminating costly due

diligence prior to securitization." (See Specification, paragraph 83). In accordance with this teaching, Claim 1 of the present application recites, "receiving said document into said database on a *flow basis* including receiving information from said document into said database as said document information becomes available for entry into said database." (See Claim 1 - emphasis added). In contrast, McDonald does not teach, disclose or suggest a "flow basis" limitation in association with the timing of its data entry.

Dependent Claims 4, 6-8, 16 and 20 depend either directly or indirectly from independent Claim 2. As McDonald does not anticipate Claim 2 for at least the reasons set forth above, McDonald fails to disclose all limitations of Claims 4, 6-8, 16 and 20 as "a dependent claim includes all the limitations of the claim from which it depends." *Wahpeton Canvas Co., Inc. v. Frontier, Inc.,* 10 USPQ2d 1201, 1208 (Fed. Cir. 1989). In addition, McDonald does not teach "flow basis" and does not anticipate Claim 21 for the reasons set forth above. Claims 22-24 depend either directly or indirectly from Claim 21 and are therefore also not anticipated by McDonald for the same reasons as Claim 21. *See Wahpeton Canvas.*

Claim 25 recites the "flow basis" limitation. For at least the reasons set forth above, McDonald does not anticipate Claim 25. Claims 26-29 depend either directly or indirectly from Claim 25. As McDonald does not anticipate Claim 25, it also does not anticipate claims that depend from Claim 25.

Claim 30, as amended, now recites the "flow basis" limitation. For at least the reasons set forth above, McDonald does not anticipate Claim 30.

In rejecting Claim 31, the Examiner relies upon McDonald paragraph 130 and FIG. 4D. There is no discussion in McDonald paragraph 130 nor in FIG. 4D regarding the

timing of the data entry, much less a "flow basis" limitation as recited in Claim 31. As such, McDonald fails to anticipate every limitation of Claim 31.

Claim Rejections under 35 U.S.C. §103 - McDonald

Claims 3, 5, 9-11, 12-14, 15, 17-19 were rejected as being obvious in view of McDonald taken in view of certain other references. One of the elements of a *prima facie* case of obviousness under 35 U.S.C. § 103(a) is that the cited reference, or references when combined, must teach or suggest all of the claim limitations. *See* MPEP § 2142.

For purposes of various arguments presented herein, applicant invites attention to MPEP §2142, which reads, in pertinent part, as follows:

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicant further invites attention to MPEP §2143.03, which is entitled "All Claim Limitations Must Be Taught or Suggested" and which reads, in pertinent part, as follows:

> To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

At least for the reasons provided above, McDonald alone or in combination with the references cited, does not teach, disclose or suggest all of the elements of the claims of the present application. As amended, Claim 2 recites that the asset information is inventoried into a database on a "flow basis." As such, any combination of references cited against the claims the Examiner rejects under §103 must teach or suggest such feature, which is not the case here.

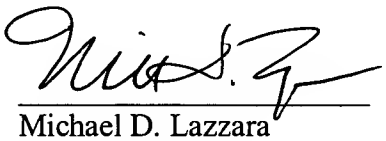
Each of Claims 3, 5, 9-11, 12-14, 15, and 17-19 depend from (either directly or indirectly) and further limit independent Claim 2. Because independent Claim 2 is allowable for at least the reasons set forth herein, it follows that each of the dependent claims is also allowable. See MPEP §2143.03 (citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) ("If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious.")

Based upon at least the foregoing reasons, McDonald as applied alone or in combination with any other reference, fails to teach all elements of the present claims. Applicant submits that a *prima facie* case of obviousness has not been established and that the claims are in condition for allowance.

Summary

Applicant respectfully requests withdrawal of the rejections set forth in the Office Action and allowance of the present application. The Examiner is invited to contact the undersigned representative by telephone to discuss any outstanding issues with the present application.

Respectfully submitted,



Michael D. Lazzara
Reg. No. 41,142
Attorney for Applicant

KIRKPATRICK & LOCKHART LLP
Henry W. Oliver Building
535 Smithfield Street
Pittsburgh, Pennsylvania 15222-2312

Telephone: (412) 355-8994
Fax: (412) 355-6501
E-Mail: mlazzara@kl.com

Customer No. 26285